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PATENT APPLICATION

ATTORNEY DOCKET NO. 10006504-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Quintin T. Phillips

Confirmation No.: 6319

Application No.: 09/932,638

Examiner: Yogesh C. Garg

Filing Date: 08/16/2001

Group Art Unit: 3625

Title: Image Forming Devices and Marketing Methods

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 11/23/2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

(X) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

(X) one month	\$120.00
() two months	\$450.00
() three months	\$1020.00
() four months	\$1590.00

() The extension fee has already been filled in this application.

() (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of \$620.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Number of pages: 25

Typed Name: Natalie King

Signature: 

Respectfully submitted,

Quintin T. Phillips

By 

James D. Shaurette

Attorney/Agent for Applicant(s)

Reg. No. 39,833

Date: 2/9/06

Telephone No.: (509) 624-4276

Rev 12/04 (Apbbrief)

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Rev 12/04 (Apibrief)

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Attorney/Agent for Applicant(s)

Reg. No. 39,833

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CENTRAL FAX CENTER**FEB - 9 2006****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application Serial No.09/932,638
Filing Date..... August 16, 2001
Inventor..... Quintin T. Phillips
Assignee..... Hewlett-Packard Development Company, L.P.
Group Art Unit 3625
Examiner..... Yogesh Garg
Attorney's Docket No. PDNO. 10006504-1
Confirmation No..... 6319
Title:Image Forming Devices and Marketing Methods

BRIEF OF APPELLANT

To: Mail Stop Appeal Brief-Patents
Commissioner of Patents
P.O. Box 1450
Alexandria VA 22313-1450

From: James D. Shaurette (Tel. 509-624-4276; Fax 509-838-3424)
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Spokane, WA 99201-3817

Appellant appeals from the final rejection, mailed August 24, 2005, of claims 9-30. The Commissioner is authorized to charge the fee required under 37 C.F.R. 5 41.20(b)(2) to Deposit Account No. 08-2025.

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I. REAL PARTY IN INTEREST

The real party in interest of this application is Hewlett-Packard Development Company, L.P. as evidenced by the full assignment of the pending application to Hewlett-Packard Company recorded starting at Reel 012272, Frame 0329, and the full assignment to Hewlett-Packard Development Company, L.P. recorded at Reel 014061, Frame 0492, in the Assignment Branch of the Patent and Trademark Office.

II. RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's undersigned legal representative, and the assignee of the pending application are aware of no appeals or interferences which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF THE CLAIMS

Claims 9-30 are pending and stand finally rejected in the Final Office Action mailed August 24, 2005 (hereinafter Office Action or Action). Appellant appeals the rejection of claims 9-30.

IV. STATUS OF AMENDMENTS

No amendments have been filed after the final rejection mailed August 24, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the subject matter defined in each of the independent claims and argued dependent claims involved in the appeal follow with respect to exemplary illustrative embodiments of the specification and figures.

Referring to claim 9, an exemplary method of the original disclosure is disclosed at Fig. 4 according to one embodiment. Step S10 illustrates accessing a condition, step S12 illustrates monitoring an operation, step S16 illustrates communicating a request, step S18 illustrates receiving a message and step S20 illustrates communicating a message. Additional details regarding the exemplary

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embodiment of Fig. 4 are described starting at paragraph 0055 of the originally-filed specification.

Referring to claims 10 and 18, details of an exemplary configuration of a consumable are shown in Fig. 2. Consumable 34a includes memory 36. Storage and accessing a condition from memory 36 of consumable 34a are described in one exemplary embodiment at paragraph 0029.

Referring to claims 16 and 23, paragraph 0063 of the originally filed specification states that the communicated request can include an identifier according to one embodiment.

Referring to claim 17, step S10 of Fig. 4 illustrates accessing a condition, step S12 illustrates monitoring an operation, step S16 illustrates communicating a request, step S18 illustrates receiving a message and step S20 illustrates communicating a message. Additional details regarding the exemplary embodiment of Fig. 4 are described starting at paragraph 0055 of the originally-filed specification. Exemplary details regarding a marketing system are illustrated in Fig. 3 and Fig. 5 and described for example starting at respective paragraphs 0053 and 0066.

Referring to claims 25 and 30, it is illustrated at steps S14 and S16 of Fig. 4 communicating the request responsive to the monitoring detecting triggering of the condition.

Referring to claim 26, Appellant respectfully submits the method is supported by at least by the exemplary disclosure of paragraphs 0004, 0042, and 0044.

Referring to claim 27, Appellant respectfully refers to the teachings of the exemplary embodiments of paragraphs 0019, 0020 and 0051 of the originally filed specification.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. The 102 rejection of claim 9.
- B. The 102 rejection of claim 17.
- C. The 102 rejection of claims 10 and 18.

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- D. The 102 rejection of claims 16 and 23.
- E. The 102 rejection of claim 23.
- F. The 103 rejection of claims 25-26 and 30.
- G. The 103 rejection of claim 27.

VII. ARGUMENT

A. Positively-recited limitations of claim 9 are not disclosed by the prior art and the anticipation rejection of claim 9 is improper for at least this reason.

The method of claim 9 positively recites *communicating a request externally of the image forming device using the image forming device*. The Office on page 7 of the Office Action recites teachings in cols. 18-19 of Sekizawa as allegedly disclosing limitations of claim 9. The Office on page 7 of the Action states that agent unit 10 monitors the operations of the printers and states that the agent unit 10 of Sekizawa communicates a request. However, referring again to the explicit claim language recited in claim 9, the method recites communicating the request *using the image forming device*. The communications of the agent unit configured to monitor the printers in Sekizawa may not be fairly considered to disclose or suggest the communicating the request using an image forming device which is configured to use a consumable to form a hard image as recited in claim 1. Fig. 1 of Sekizawa clearly discloses printers P distinguished from agent unit 10. Agent unit 10 does not use a consumable as recited in the claims and agent unit 10 is not disclosed as being configured to form a hard image upon media such as paper as defined in paragraph 20 of the specification. The claimed communicating the request using the image forming device is not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

At col. 19, lines 20+ of Sekizawa, it is stated that agent unit 10 gets status information ϕ 1 and prepares status mail ϕ 2 storing the status information ϕ 1 and

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which is sent to mail server 19. Neither of the status information ϕ 1 nor status mail ϕ 2 are disclosed as comprising a request. In no fair interpretation may the status information communicated by the printers P or the status mail ϕ 2 of Sekizawa be considered to disclose or suggest the communication of a request. Further, the communication of ϕ 2 is performed by the agent unit 10 which may not be fairly considered to disclose or suggest the claimed communicating the request using the image forming device.

Furthermore, even if the information sent by the agent unit set forth on page 7 of the Action is considered to disclose communications using an image forming device (which interpretation is contrary to the teachings of Sekizawa), the communications of status mail by the agent unit 10 may not be fairly considered to disclose the communication of the request. The Office on page 7 of the Action relies upon the generic Summary of the Invention teachings of col. 5 of Sekizawa as allegedly disclosing the communication of the request using the image forming device. Initially, the generic teachings of col. 5 are void of teachings regarding an agent unit or printer and have not been demonstrated to have any relevance thereto. Assuming *arguendo*, the teachings of col. 5 pertain to the operations of an agent unit, the mere communication of status mail or status information communicates exactly that, status information. Using the Office's definition of a request as an act of asking or sending a message for something to be done or given provided on page 7 of the Action, it is clear the status information or status mail fails to disclose the communication of a request. The status information or mail is not disclosed as an act for asking for anything or for sending a message for something to be done or given but is clearly disclosed as *merely status*. Col. 5, lines 45 + of Sekizawa states that if the operator recognizes that an abnormal state requires maintenance, then the integrated monitor unit can provide various services. Accordingly, it is clear that the device receiving the status information processes it to determine whether action is needed and the status communications from the printers or agents of Sekizawa are not disclosed as requests.

Independent claim 9 also recites receiving a message responsive to the communicating the request which is not disclosed by Sekizawa. At page 2 of the Action, the Office relies upon teachings of col. 19 of Sekizawa regarding the

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monitor unit 20 installed in an agency. Such teachings fail to disclose or suggest receiving a message. At page 2 of the Action, the Office relies upon the teachings of col. 5, lines 32-50 of Sekizawa. However, the teachings relied upon fail to disclose teachings regarding a printer as baldly alleged by the Office or any receiving of a message as claimed. The teachings of cols. 5 and 19 of Sekizawa fail to disclose or suggest the claimed receiving the message responsive to the communicating the request and the anticipation rejection of claim 9 is improper for at least this reason.

Independent claim 9 also recites communicating the message (which was received responsive to communicating the request) using an image forming device. The teachings in cols. 5 and 19 relied upon by the Office on page 2 of the Action as allegedly disclosing the claimed communicating the message fail to even mention a printer let alone any communicating using the printer. The Office has failed to identify and Appellant has failed to identify any communicating of the claimed message (received responsive to the communicating the request) using an image forming device. The anticipation rejection is improper for this additional reason.

As demonstrated above, numerous limitations of claim 9 are not disclosed nor suggested by the prior art. The teachings identified by the Office clearly do not support a proper anticipation rejection and Appellant respectfully requests withdrawal of the anticipation rejection and allowance of claim 9.

B. Positively-recited limitations of claim 17 are not disclosed by the prior art and the anticipation rejection of claim 17 is improper for at least this reason.

Claim 17 recites communicating a request using the image forming device. Sekizawa merely discloses the printers communicating status information $\phi 1$. The mere communication of status information may not be fairly considered to disclose or suggest the claimed request or an act of asking or sending a message for something to be done or given as defined by the Office on page 7 of the Action. The status information $\phi 1$ is not a request, an act of asking, nor is it a message for something to be done or given. Furthermore, the communication of status mail $\phi 2$ fails to disclose or suggest any communicating using an *image forming device*.

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Furthermore, status mail ϕ 2 is not a request, an act of asking nor a message for something to be done or given. Sekizawa fails to disclose or suggest communicating a request using the image forming device as claimed and claim 17 is allowable for at least this reason.

Claim 17 further recites *communicating the request using the image forming device to a marketing system*. The Office on page 7 relies upon the teachings of unit 20 as allegedly disclosing the claimed marketing system. Initially, the printers of Sekizawa are not disclosed as implementing any communications with unit 20 and accordingly any teachings with respect thereto are irrelevant of disclosing *communicating the request using the image forming device to a marketing system*. Assuming *arguendo*, printers of Sekizawa do communicate with unit 20, Sekizawa is void of any teachings of unit 20 disclosing a marketing system as claimed. At page 7 of the Action, the Office contends that unit 20 corresponds to a unit of a marketing system as it organizes delivery schedules of consumables. Appellant respectfully submits the organization of a schedule fails to disclose or suggest any marketing teachings or the claimed marketing system. The organizer of delivery schedules of consumables may be considered to be a schedule organizer but can not be interpreted to disclose any marketing teachings. Appellant has electronically searched Sekizawa and failed to uncover any mention of marketing in Sekizawa. The communicating the request to a marketing system as defined in claim 17 is not disclosed nor suggested by the prior art and claim 17 is allowable for at least this reason.

Claim 17 recites *communicating a message using the marketing system responsive to receiving the request*. At page 2 of the Action, the Office relies upon teachings of col. 19 of Sekizawa regarding the monitor unit 20 installed in an agency. Such teachings fail to disclose or suggest any communication of a message. At page 2 of the Action, the Office relies upon the teachings of col. 5, lines 32-50 of Sekizawa. However, the teachings relied upon in col. 5 fail to mention unit 20 identified as allegedly disclosing the claimed marketing system. Furthermore, the teachings of col. 5 fail to disclose communication of a message responsive to receiving the request as claimed. The teachings of cols. 5 and 19 of Sekizawa fail to disclose or suggest the claimed communicating and the anticipation rejection of claim 17 is improper for at least this reason.

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Claim 17 also recites *communicating the message (which was communicated by the marketing system) using the image forming device*. The teachings in cols. 5 and 19 relied upon by the Office as allegedly disclosing the claimed communicating the message *fail to even mention a printer P of Sekizawa let alone any communicating using the printers P*. The Office has failed to identify and Appellant has failed to identify any communicating of the claimed message (communicated using the marketing system) using an image forming device. The anticipation rejection is improper for this additional reason.

As demonstrated above, numerous limitations of claim 17 are not disclosed nor suggested by the prior art. The teachings identified by the Office clearly do not support a proper anticipation rejection and Appellant respectfully requests withdrawal of the anticipation rejection and allowance of claim 17.

C. Positively-recited limitations of claims 10 and 18 are not disclosed by the prior art and the anticipation rejection of claims 10 and 18 is improper for at least this reason.

Referring to dependent claims 10 and 18, the methods recite *accessing the condition from the consumable* in combination with the limitations of accessing the condition associated with an operation of the image forming device configured to use a consumable and the condition is associated with an operation of the device which is monitored. On pages 3 and 8 of the Action, the Office relies upon the teachings of col. 9, lines 12-40 of Sekizawa as allegedly teaching the limitations of claims 10 and 18. Once again, the Office relies upon generic teachings of the Summary of Invention which fail to disclose the above-identified limitations. The generic teachings of col. 9 merely state that an integrated monitor unit gets and retains status information containing remaining amount information of a consumable article. Appellant has failed to identify any teachings regarding a condition associated with an operation of the image forming device as claimed. Appellant has *failed to identify any teaching that a condition is accessed from the consumable itself* as positively claimed. The generic teachings in col. 9 do not disclose how the status information of the consumable is obtained, and regardless, the status information fails to disclose or suggest the claimed condition let alone accessing the condition from the consumable itself. The teachings at lines 12-40 of col. 9 of

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Sekizawa relied upon by the Office fail to disclose or suggest the claimed *accessing of anything from a consumable let alone the specifically claimed accessing of the condition associated with an operation of the image forming device from the consumable.*

At page 8 of the Action, the Office also relies upon the teachings of col. 19, lines 21-35 of Sekizawa in support of the rejection. Such teachings merely generically disclose the agent unit 10 getting status information and fail to disclose any teachings regarding a condition or that the condition is accessed from the consumable. More specifically, the identified teachings of col. 19 merely state that agent unit 10 gets status information from the printer and which includes information regarding a status of a consumable. The identified teachings do not teach or suggest *accessing a condition associated with an operation of the image forming device from the consumable* as claimed.

Further, the teachings of cols. 16-17 of Sekizawa relied upon by the Office again refer to generic embodiments of the Summary and fail to cure the deficiencies of the teachings in col. 19 or other teachings of the detailed description of Sekizawa. In particular, the identified teachings of Sekizawa refer to computer-readable medium and getting status information containing amount information of a consumable article and fails to disclose any teachings of the claimed condition or accessing the condition from the consumable itself.

As demonstrated above, numerous limitations of claims 10 and 18 are not disclosed nor suggested by the prior art. The teachings identified by the Office clearly do not support a proper anticipation rejection and Appellant respectfully requests withdrawal of the anticipation rejection and allowance of the claims.

D. Positively-recited limitations of claims 16 and 23 are not disclosed by the prior art and the anticipation rejection of claims 16 and 23 is improper for at least this reason.

The methods recite *communicating the request including an identifier of the image forming device using the image forming device*. The Office at page 10 of the Action relies upon teachings of Fig. 17 and cols. 20-21 of Sekizawa as allegedly disclosing the limitations of the claims. However, Fig. 17 refers to a *printer registration log file which is retained within the agent unit 10* (col. 17, lines 51-55,

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col. 19, line 45 - col. 20, line 1), and Appellant has been unable to locate any teachings of a request communicated by the printer P of Sekizawa including an identifier of the printer.

Furthermore, with respect to the teachings of cols. 20-21 of Sekizawa, such teachings refer to operations of the agent unit 10 as evidenced by Fig. 3 of Sekizawa as opposed to the printer and the teachings fail to disclose *communicating the request using the image forming device and the request including the identifier of the image forming device*. The operations of the agent unit external of the printers P of Sekizawa fail to teach or suggest *communicating the request including the identifier of the image forming device using the image forming device* as claimed. The Office on page 10 of the Action parenthetically generically states "when sending requests/messages include identifiers." However, the Office *has failed to present any prior art teachings of Sekizawa that requests or messages which include identifiers of an image forming device are communicated using the image forming device*.

Limitations of claims 16 and 23 are not disclosed nor suggested by the prior art and claims 16 and 23 are allowable for this additional reason. Appellant respectfully urges withdrawal of the erroneous anticipation rejection and allowance of the claims at this time.

E. Positively-recited limitations of claim 23 are not disclosed by the prior art and the anticipation rejection of claim 23 is improper for at least this reason.

Claim 23 recites *selecting the message from a plurality of other messages using the identifier of the image forming device and communicating the message after the selecting*. The Office on page 10 of the Action relies upon the teachings of col. 19, lines 15-35 of Sekizawa as allegedly disclosing the above-recited teachings. However, the teachings of col. 19, lines 15-35 relied upon by the Office merely refer to a console unit reading a large number of pieces of mail. Reading a large number of pieces of mail of col. 19 fails to disclose or suggest the claimed *selecting a message from a plurality of other messages using the identifier of the image forming device alone or in combination with the communication of the*

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request including an identifier of the image forming device using the image forming device as specifically defined in claim 23.

Furthermore, the Office relies upon the teachings of col. 35, lines 16-27 of Sekizawa as allegedly teaching the selecting the message recited in claim 23. The teachings relied upon by the Office refer to change mail ϕ 4 which have not been demonstrated to comprise a request communicated by a printer of Sekizawa or that a message is selected using the identifier as positively claimed.

Positively-recited limitations of the claims are not disclosed nor suggested by the prior art and claim 23 is allowable for this additional reason. Appellant respectfully urges withdrawal of the erroneous anticipation rejection and allowance of the claims at this time.

F. There is insufficient motivation to combine the reference teachings of Hayward and the teachings of Sekizawa and the rejection of claims 25-26 and 30 is improper.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 3).

MPEP 2142 (8th ed., rev. 3) states that the concept of *prima facie* obviousness allocates who has the burden of going forward with production of evidence in each step of the examination process and the *examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness*. The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness, that is, the initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. MPEP §2142 (8th ed., rev. 3).

Appellant respectfully submits the motivational rationale is insufficient in view of precedent set forth by the Federal Circuit, and accordingly, the Office has failed to meet their burden of establishing a proper *prima facie* 103 rejection.

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The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and *can not be resolved on subjective belief and unknown authority*. The Court also stated that *deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense but rather specific factual findings are needed*. The Court further stated that the determination of patentability must be based on evidence. MPEP 2143.01 (8th ed., rev. 3) cites *In re Lee* and states the importance of relying upon objective evidence and making specific factual findings with respect to the motivation to combine references.

In support of the 103 rejection, the Office on pages 12-13 of the Action baldly states that the combination is appropriate because rather to wait and read mails about the status of a condition an automatic communication to the resource for replenishment of a replacement part or consumable item or to send maintenance personnel for an abnormal failure would result in reducing the downtime of the printer. The alleged motivation is insufficient in view of applicable authority.

More specifically, despite the authority regarding supporting evidence, the Office has provided no evidence whatsoever in support of the bald, cursory unsupported allegations presented on pages 12-13 of the Action. The Office has failed to present any evidence that the comprehensive system of Sekizawa suffers from any downtime or that, even if such were present, that downtime would be reduced by the combination proposed by the Office. The Office has failed to present any evidence whatsoever that any improvements to the arrangement of Sekizawa would result from the modification proposed by the Office compared to the teachings of Sekizawa taken by themselves to motivate one to combine the reference teachings.

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It is clear from the objective teachings of Sekizawa that the bald motivation presented by the Office is without merit. More specifically, Appellant respectfully refers to the explicit teachings in Sekizawa at col. 21, lines 62+ wherein it is stated that the control section 15 of agent unit 10 causes the local information getting section 11 to get the status information ϕ 1 from printers at every first time period T1. The control system controls the local information getting section 11 of the agent unit 10 to get the status information ϕ 1 at every minute from the network printer P per col. 22, lines 7+. Furthermore, Sekizawa provides a time where a user may correct the error and if not corrected the agent unit immediately dispatches a request for maintenance personnel per col. 22, lines 15+. Accordingly, there is no evidence of record that the operations of Sekizawa are deficient to cause one to look to other references for other teachings. There is no evidence of record that if Sekizawa were modified to perform the push operations of claims 25, 26, 30 that any improvements over the explicit polling operations of Sekizawa per col. 21, lines 62+ would result. There is insufficient motivation to combine the reference teachings and the 103 rejection is improper for at least this reason.

Furthermore, to change the comprehensive polling arrangement to a push system would change the principle of operation of Sekizawa further illustrating the inappropriateness of the modifications proposed by the Office. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP §2143.01VI. (8th ed., rev. 3) citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Appellant respectfully submits the Office has failed to identify any evidence in support of the bald allegations regarding motivation to combine the reference teachings. Furthermore, the explicit teachings of Sekizawa provide a comprehensive detailed arrangement which has not been demonstrated to be deficient. To the contrary of the unsupported allegations of Office regarding Sekizawa experiencing downtime, the Sekizawa arrangement explicitly accommodates failed printers and expedites servicing. The rationale alleged by the Office is redundant in view of the already explicit teachings of Sekizawa regarding

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accessing of information of printers and insufficient to support a proper 103 rejection.

Appellant respectfully submits for at least the above-mentioned reasons, the Office has failed to meet their burden of establishing proper motivation to combine the reference teachings. The Office has failed to establish a proper prima facie 103 rejection and Appellant respectfully requests withdrawal of the 103 rejection.

G. Limitations of claim 27 are not disclosed by the prior art, the reliance upon Official Notice is traversed and improper and the rejection of claim 27 is improper.

Claim 27 recites the *communicating the message using the image forming device comprises printing the message upon paper in combination with other limitations* of claim 9. The combination of limitations are not well known, have not been demonstrated to be well known, and any reliance upon official notice is improper. Appellant has previously traversed in the Pre-Appeal Conference Brief filed November 23, 2005 and hereby again traverses reliance upon Official Notice pursuant to MPEP §2144.03 (8th ed., rev. 2). MPEP 2144.03A (8th ed., rev. 2) provides that *official notice unsupported by documentary evidence should only be taken by the examiner when the facts asserted to be well known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known*. Appellant respectfully submits claims are analyzed in the context of the combination of the various separately stated limitations, and not with respect to the limitations individually. There is absolutely no evidence of record of the claimed *printing of a message upon paper where the message was received responsive to a request which was communicated externally of the image forming device responsive to monitoring of an operation of the image forming device* as explicitly claimed. The claims do not merely recite printing on paper but rather specifically recite numerous additional limitations in combination when the claim limitations are properly read as a whole. The claim limitations when properly read as a whole are not and have not been demonstrated to be well known. It is ***not appropriate*** for the Office to take official notice of facts without a reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. MPEP 2144.03. The fact that no evidence

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has been offered by the Office is compelling evidence that the reliance upon official notice is improper and the fact that the limitations recited in claim 27 are not disclosed in the prior art is compelling evidence that the claim limitations recite patentable subject matter.

Appellant respectfully requests reversal of the rejection and allowance of claim 27.

H. Conclusion

In view of the foregoing, reversal of the rejections of the claims is respectfully requested. For any one of the above-stated reasons, the rejections of the respective claims should be reversed. In combination, the above-stated reasons overwhelmingly support such reversal. Accordingly, Appellant respectfully requests that the Board reverse the rejections of the claims.

Respectfully submitted,

Date: 2/9/06

Attorney: 

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VIII. CLAIMS APPENDIX

Claims 1-8 are canceled.

1 9. [Original] A marketing method comprising:
2 accessing a condition associated with an operation of an image forming
3 device configured to use a consumable to form a hard image;
4 monitoring the operation of the image forming device;
5 communicating a request externally of the image forming device using the
6 image forming device and responsive to the monitoring;
7 receiving a message responsive to the communicating the request; and
8 communicating the message using the image forming device.

1 10. [Original] The method of claim 9 wherein the accessing comprises
2 accessing the condition from the consumable.

1 11. [Original] The method of claim 9 wherein the accessing comprises
2 accessing the condition related to a status of the consumable and the monitoring
3 comprises monitoring the status of the consumable.

1 12. [Original] The method of claim 9 wherein the accessing comprises
2 accessing the condition not related to a status of the consumable.

1 13. [Original] The method of claim 9 wherein the accessing comprises
2 accessing the condition related to a life span of the image forming device and
3 the monitoring comprises monitoring the life span of the image forming device.

1 14. [Original] The method of claim 9 wherein the accessing comprises
2 accessing the condition related to a status of another consumable not having
3 the condition, and the monitoring comprises monitoring the status of the another
4 consumable.

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1 15. [Original] The method of claim 9 wherein the accessing comprises
2 accessing a plurality of conditions related to statuses of a plurality of
3 consumables used by the image forming device to form the hard image, and the
4 monitoring comprises monitoring the statuses of the consumables.

1 16. [Original] The method of claim 9 wherein the communicating the
2 request comprises communicating the request including an identifier of the
3 image forming device.

1 17. [Original] A marketing method comprising:
2 accessing a condition associated with an operation of an image forming
3 device configured to use a consumable to form a hard image;
4 monitoring the operation of the image forming device;
5 communicating a request using the image forming device to a marketing
6 system external of the image forming device responsive to the monitoring;
7 communicating a message using the marketing system responsive to
8 receiving the request; and
9 communicating the message using the image forming device.

1 18. [Original] The method of claim 17 wherein the accessing
2 comprises accessing the condition from the consumable.

1 19. [Original] The method of claim 17 wherein the accessing
2 comprises accessing the condition related to a status of the consumable and the
3 monitoring comprises monitoring the status of the consumable.

1 20. [Original] The method of claim 17 wherein the accessing
2 comprises accessing the condition not related to a status of the consumable.

1 21. [Original] The method of claim 17 wherein the accessing
2 comprises accessing the condition related to a life span of the image forming
3 device and the monitoring comprises monitoring the life span of the image
4 forming device.

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1 22. [Original] The method of claim 17 wherein the accessing
2 comprises accessing the condition related to a status of another consumable not
3 having the condition, and the monitoring comprises monitoring the status of the
4 another consumable.

1 23. [Original] The method of claim 17 wherein the communicating the
2 request comprises communicating the request including an identifier of the
3 image forming device, and further comprising selecting the message from a
4 plurality of other messages using the identifier, and wherein the communicating
5 the message comprises communicating the message after the selecting.

1 24. [Previously Presented] The method of claim 9 wherein the
2 monitoring comprises monitoring the operation of the image forming device with
3 respect to the condition.

1 25. [Previously Presented] The method of claim 24 wherein the
2 communicating the request comprises communicating responsive to the
3 monitoring detecting the operation of the image forming device triggering the
4 condition.

1 26. [Previously Presented] The method of claim 9 wherein the
2 communicating comprises communicating the message comprising marketing
3 information regarding purchase of an item associated with the formation of hard
4 images.

1 27. [Previously Presented] The method of claim 9 wherein the
2 communicating the message comprises printing the message upon paper.

1 28. [Previously Presented] The method of claim 9 wherein the
2 communicating the message comprises displaying the message using a display
3 of the image forming device.

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1 29. [Previously Presented] The method of claim 17 wherein the
2 monitoring comprises monitoring the operation of the image forming device with
3 respect to the condition.

1 30. [Previously Presented] The method of claim 29 wherein the
2 communicating the request comprises communicating responsive to the
3 monitoring detecting the operation of the image forming device triggering the
4 condition.

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IX. EVIDENCE APPENDIX

Appellant submits no evidence with this appellate brief.

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X. RELATED PROCEEDINGS APPENDIX

Appellant is not aware of any related proceedings.

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